

Remarks

Reconsideration of this Application is respectfully requested.

Claims 12, 14, 15 and 23 are pending in the application, with claim 12 being the independent claim. Claim 15 has been withdrawn from consideration, and is sought to be reinserted into the application upon allowance of generic, linking claim 12.

Based on the following remarks, Applicant respectfully requests that the Examiner reconsider all outstanding rejections and that they be withdrawn.

Rejection under 35 U.S.C. § 102

Claims 12, 14, and 23 were finally rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by U.S. Patent No. 6,375,176 to Getchel *et al.* ("Getchel"). Applicant respectfully traverses this rejection.

Independent claim 12 is patentable over Getchel because Getchel does not expressly or inherently disclose "an expandable annular tube coupled to the wafer chuck and configured to expand the wafer chuck." *See Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987) ("A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.").

The Office Action analogizes circulating tubes of Getchel (Getchel FIG. 11A, element 580) to the annular tube of claim 1. But the circulating tubes of Getchel are used to circulate a cooling fluid within the chuck (Getchel col. 8, lines 44-45) that cools the chuck (Getchel col. 15, lines 13-18). Therefore, the circulating tubes of Getchel are not the same as "an expandable annular tube coupled to the wafer chuck and configured

to expand the wafer chuck" as recited in claim 12. In contrast, circulating cooling fluids through the circulating tubes of Getchel will cause contraction of the chuck.

The Office Action, on pages 3 and 4, states:

No where in the claims does it require the chuck to be expanded by directly heating the annular tube. Thus, Getchel anticipates the claims by disclosing the use of heater coils to heat and expand the chuck 533. In regards to whether the annular tube is expandable or not, it is respectfully submitted that the material (e.g. metal, plastic, etc.) of the tube will expand when being subjected to a certain critical temperature.

In response to the Office Action's assertion, Applicant states that heat sink/heater assembly 532 of FIG. 11A of Getchel includes heater coils that are used to heat the chuck that might result in expansion of the heat sink/heater. However, these heater coils of Getchel are not the same as "an expandable annular tube coupled to the wafer chuck and configured to expand the wafer chuck" as recited in claim 12. The Office Action admits that it is the heater coils of Getchel (not the circulating tubes of Getchel) that expands the chuck. Therefore, Getchel does not anticipate claim 12 because Getchel fails to disclose this element of claim 12.

M.P.E.P. § 2112.01 states that:

Where the claimed and prior art products are identical or substantially identical in structure or composition, or are produced by identical or substantially identical processes, a prima facie case of either anticipation or obviousness has been established. In re Best, 562 F.2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977). "When the PTO shows a sound basis for believing that the products of the applicant and the prior art are the same, the applicant has the burden of showing that they are not." In re Spada, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990). Therefore, the prima facie case can be rebutted by evidence showing that the prior art products do not necessarily possess the

characteristics of the claimed product. In re Best, 562 F.2d
at 1255, 195 USPQ at 433.

(Emphasis in original.)

Thus, in rebuttal of the present rejection, Applicant submits that the heater elements and cooling tubes of Getchel do not *necessarily* possess the characteristics of the claimed invention.

Moreover, Applicant asserts that Getchel teaches away from the claims. The circulating tubes of Getchel are specifically designed to cool (and therefore cause thermal contraction to) a wafer chuck. This alone would teach the skilled person away from Getchel to meet the pending claims. See *Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc.*, 796 F.2d 443, 230 U.S.P.Q. 416 (Fed. Cir. 1986) (stating that a reference should be considered as a whole, and portions arguing against or teaching away from the claimed invention must be considered); and *In re Gurley*, 27 F.3d 551, 31 U.S.P.Q.3d 1130 (Fed. Cir. 1994) ("A reference may be said to teach away when a person of ordinary skill, upon reading the reference, ...would be led in a direction divergent from the path that was taken by the applicant.").

Therefore, Getchel does not anticipate claim 12 because Getchel fails to disclose each element of claim 12. Dependent claims 14 and 23 are likewise patentable over Getchel for at least the same reason as independent claim 12 from which they depend, and further in view of their own respective features. Accordingly, Applicant respectfully requests that the rejection of claims 12, 14 and 23 be reconsidered and withdrawn.

Reply to Office Action of April 3, 2009

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Appl. No. 10/780,877

Request for Reconsideration of Non-Elected Claims/Species Restriction

The Office Action states, "[C]laim 15 remains withdrawn from further consideration as being directed to a non-elected invention." (Office Action, page 2). Applicant asserts that at least claim 12 is a generic linking claim. This was discussed previously in the Reply to Requirement for Election of Species filed March 10, 2006. Claim 12 links claim 15. As claim 12 should now be found allowable, claim 15 should be brought back into the application and found allowable, at least based on its dependency to claim 12. (See M.P.E.P. §809).

Reconsideration and withdrawal of the election of species requirement is respectfully requested.

Reply to Office Action of April 3, 2009

Peter Kochersperger
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Conclusion

All of the stated grounds of objection and rejection have been properly traversed, accommodated, or rendered moot. Applicant therefore respectfully requests that the Examiner reconsider all presently outstanding objections and rejections and that they be withdrawn. Applicant believes that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Prompt and favorable consideration of this Amendment and Reply is respectfully requested.

Respectfully submitted,

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Date: April 22, 2009

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